IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Dany Sylvain   Examiner: Man U. Phan
Serial No. 10/824,226   Art Unit: 2616
Filed: 04/14/2004
For: **ADAPTIVE DIALING**

Mail Stop Amendment
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

<u>DECLARATION UNDER 37 C.F.R. § 1.131 OF BENJAMIN S. WITHROW</u>

1.   My name is Benjamin S. Withrow of the law firm of Withrow & Terranova, PLLC, and I am a registered U.S. patent attorney, Registration No. 40,876.

2.   Starting in 2000, and continuing until the present time, I have been retained as outside counsel for Nortel Networks Limited (hereinafter "Nortel"), the assignee of the present application.

3.   On or about January 20, 2004, I received instructions from Nortel to prepare and file a patent application for an Invention Disclosure entitled "Adaptive Dialing," which is attached to this Declaration as Appendix A (hereinafter "Invention Disclosure"). This Invention Disclosure was assigned attorney docket number 7000-341.

4.   The Invention Disclosure was submitted by the inventor, Dany Sylvain, on December 5, 2003.

5.   Prior to January 20, 2004, I received instructions from Nortel to prepare and file patent applications for a number of previous Invention Disclosures.

6.   From the time of receiving instructions from Nortel to prepare and file patent applications for a number of previous Invention Disclosures until about April 14, 2004, I worked to prepare

patent applications for the number of previous Invention Disclosures in essentially a chronological, first-in-first-out fashion.

7.   Starting from a period soon after January 20, 2004, and continuing through April 14, 2004, I diligently reviewed the Invention Disclosure, met with the inventor Dany Sylvain, and diligently worked to prepare a patent application (hereinafter "Patent Application") claiming the invention disclosed in the Invention Disclosure.

8.   On February 26, 2004, my assistant, Jennifer Alkove, sent a first draft of the Patent Application (hereinafter "First Draft") to the inventor, as evidenced by the e-mail attached to this Declaration as Appendix B.

9.   On March 12, 2004, I received minor comments from the inventor regarding the First Draft, as evidenced by the excerpt from a spreadsheet attached to this declaration as Appendix C.

10.   On March 15, 2004, I revised the Patent Application to incorporate the comments from the inventor for the First Draft, and sent a revised Patent Application to in-house counsel at Nortel, as evidenced by the spreadsheet attached to this declaration as Appendix C.
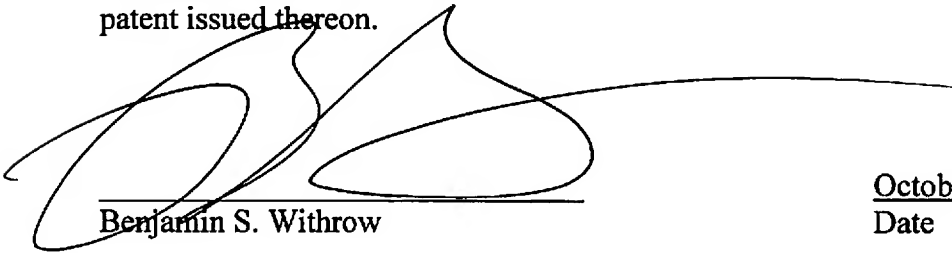
11.   On March 15, 2004, my assistant, Jennifer Alkove, sent a copy of the revised Patent Application and the inventor declaration and assignment document to the inventor to be signed, as evidenced by the spreadsheet attached to this declaration as Appendix C.

12.   On March 19, 2004, I received a signed inventor declaration and assignment document from the inventor, as evidenced by the spreadsheet attached to this declaration as Appendix C.

13.   On April 13, 2004, I received approval from in-house counsel at Nortel to file the Patent Application substantially as drafted in the Patent Application sent to in-house counsel on March 19, 2004, as evidenced by the spreadsheet attached to this declaration as Appendix C.

14.   On April 14; 2004, the Patent Application was filed with the U.S. Patent & Trademark Office and was assigned Application Serial Number 10/824,226.

15.   I hereby declare that all declarations made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Benjamin S. Withrow

October 30, 2007
Date

Appendix A

N**O**RTEL
NETWORKS

John R. Witcher, III
Senior Counsel

January 20, 2004

VIA FEDERAL EXPRESS

Mr. Benjamin Withrow, Esq.
Withrow & Terranova
201 Shannon Oaks Circle
Suite 200
Cary, NC 27511

Re: Invention Docket No.:
**   Title: *Adaptive Dialing***

Dear Ben:

Nortel Networks would like to retain you to prepare and file in the United States Patent and Trademark Office (USPTO) a patent application directed to the invention disclosed in the enclosed invention disclosure by the above-referenced filing date. The application should be prepared according to Nortel Networks guidelines in accordance with the predetermined fee we have agreed with your firm. If you are unable to perform the requested work, please advise me immediately.

In addition to the invention disclosure, an invention disclosure Review Summary document is enclosed for your consideration. We request that you contact the primary inventor, Dany Sylvain, at   within two weeks of receiving this letter. Please ensure that the inventor(s) are advised of their responsibilities regarding their duty of candor to the USPTO, as well as any other relevant rules and/or laws including the best mode requirement.

Questions pertaining to substantive issues associated with the application should be addressed with me, while administrative issues associated with the application should be addressed with Theresa Boyce. Please be sure that all communications associated with the application, including billing statements and the application itself bear the above-referenced disclosure number.

Please send a substantially complete and final draft of the application to me along with a completed Nortel Networks Outsource's Patent Application Checklist at least 10 days prior to the above-referenced filing date to provide Nortel Networks' Intellectual Property Law Group sufficient opportunity to review the application prior to filing. You should seek to obtain the signatures on the formal papers from all inventors directly.

Please confirm receipt of this disclosure via facsimile to the above-identified number. Please include your assigned reference number.

Upon filing the application with the USPTO, immediately fax a copy of the application transmittal letter to me, so that we have a record that the application has been filed. Thereafter, please send me a hardcopy of the application as filed along with an electronic copy in Microsoft Word 6.0 readable format on a 3 ½" floppy disk.

Should you have any questions, please call me at

Very truly yours,

Rick

Rick Witcher

Enclosures: Invention Disclosure No.:
                    Review Summary
                    Patent Application Outsource Checklist

JRW:slw

cc: Dany Sylvain

Invention Disclosure Submission Reply

DEC - 5 2003

Disc No:		Received Date:	05 dec 2003
Disclosure Title:	Adaptive dialing		

---=== Inventors ===---

Global ID	Name	Work Info	Home Info
1504851	HR Name: SYLVAIN, DANY Known As: DANY Email: Mgr First Name: STEPHEN Mgr Last Name: ELLIOTT Mgr Global ID:	Location: Location Code: Dept: Phone: Ext Phone: Fax: Ext Fax: MailStop: Citizenship:	Address: Phone:

---=== Attachments ===---

File Name	File Type	File Comments
adaptive_dialing_2.ppt	Microsoft Powerpoint (*.ppt)	

<End of Attachments>

Were there additional inventors involved?	no	Was there contractor involvement?	no
Name of Supervisor or Divisional Head		Name of VP	
STEVE ELLIOTT		SUE SPRADLEY	
LOB:	WIRELINE NETWORKS**	Business Unit:	CTL/VOIP
Conception Date:			

Has this invention been discussed with others? If so, please complete:

Inside Nortel: Whom?		Outside Nortel: Whom?	
Inside Nortel: When?		Outside Nortel: When?	
NDA?	no		

Are you aware of any imminent future disclosures? Please provide dates and details

Keywords for Searching:	Products that will use this invention:
Dialing, dual mode handset, location	

Does this invention arise from any arrangement involving an external organization?	no

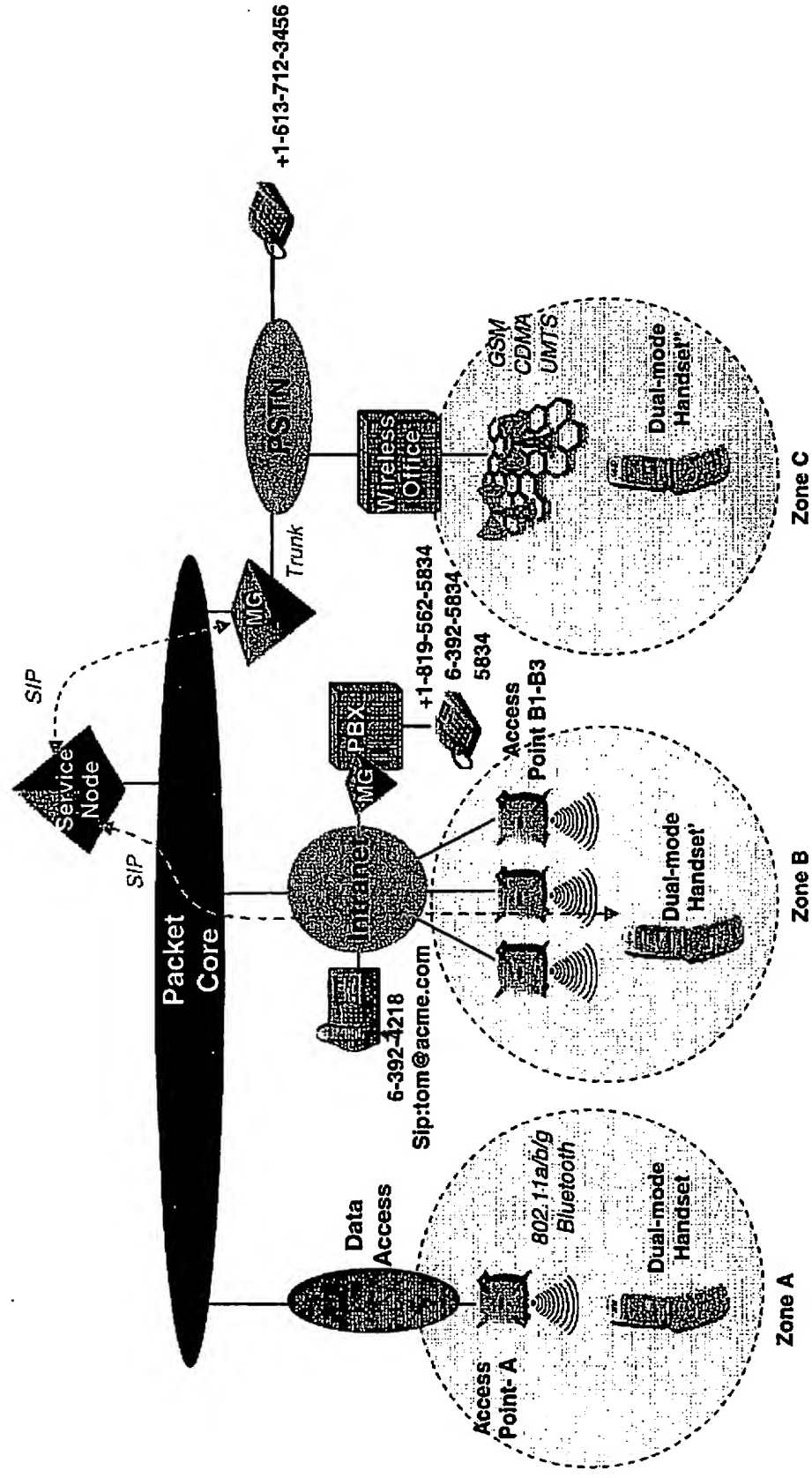| Is this invention relevant to a Standards Activity?	Internal Funding Project #s:
no	

If so, give details:

Technical Information

Brief Description of the Invention:

-Automatically selecting an address for a terminating party based on the originator network connectivity
- Network connectivity is cellular network
- Network connectivity is WLAN/Bluetooth network
- Network connectivity is a specific WLAN/Bluetooth access point
- Selection is done by specifying a terminating party name
- Selection is one of multiple address entries for a terminating party
- Address entry is one of
    public E.164 address, private E.164 address, international E.164 address,
    abbreviated dialing E.164 address, sip address, url address
- Modifying the selected address based on originator network connectivity
- Adding a prefix, removing a prefix
- Substituting a portion of the address
- Querying a service node for the public E.164 alias for a sip address entry, storing the public E.164 address in association with the sip address entry

Problem Solved by the Invention:

Dual mode handsets can initiate calls from various locations: cellular network, from an enterprise WLAN network, from home. Depending on those locations, the number that needs to be dialed will vary. A typical problem is the local personal directory for the handset contains entries for frequently dialed numbers. If the user is an enterprise user, the entries may contain the ESN number of collegues or the 4-digit extension number. When dialing from the enterprise WLAN zone, the ESN or 4-digit number will work fine. However, if it's used on the cellular network these numbers won't work.

To get around this issue, this invention proposes two options: store multiple entries for the user and let the handset automatically select the appropriate entry based on the current network connectivity. The second option consists in altering the stored number based on pre-established rules, such as translating an ESN number to a public number using a local map.

A second problem solved is automating the process of retrieving an E.164 alias for a SIP address.

Solutions that have been tried and why they didn't work:

Modem dialers allow the selection of various prefix (e.g. 9) based on user location: users need to manually select the prefix; no address substitution or modificatiion is done

Multiple numbers can be stored in a personal directory for a same user: again the caller needs to select manually the entry.

Specific elements or steps that solved the problem and how they do it:

See chart for some additional *details*

Commercial value of the invention to Nortel and Nortel's major competitors

This problem surfaced during the definition of the dual mode handset system solution (personal mobile communicator). This invention, although easy to implement, will significantly improve the usability of PMC, a critical factor for market acceptance. In addition, by automating the translation of sip addresses to E.164 aliases, this will also make it easier for users to start using sip addresses as the main address for users (the E.164 being the backup one), helping accelarating the transition to sip addresses, a more natural form of addressing for users.

Network

Rough claims

- **Automatically selecting an address for a terminating party based on the originator network connectivity**
  - Network connectivity is cellular network
  - Network connectivity is WLAN/Bluetooth network
  - Network connectivity is a specific WLAN/Bluetooth access point
- **Selection is done by specifying a terminating party name**
- **Selection is one of multiple address entries for a terminating party**
  - Address entry is one of public E.164 address, private E.164 address, international E.164 address, abbreviated dialing E.164 address, sip address, url address
- **Modifying the selected address based on originator network connectivity**
  - Adding a prefix, removing a prefix
  - Substituting a portion of the address
- **Querying a service node for the public E.164 alias for a sip address entry, storing the public E.164 address in association with the sip address entry**

Appendix B

From:	Jennifer Alkove
Sent:	Thursday, February 26, 2004 11:50 AM
To:	'sylvain@nortelnetworks.com'
Cc:	Ben Withrow
Subject:	First Draft of ⁻ (our file 7000-341)

First Draft.zip (...

            Suspicious files were found in the attachments.
The file ⁚   First Draft.zip: Contains password-protected files

The original message follows:
Dear Dany:

Please find attached a first draft of the above-referenced patent application. The .zip
file is protected with the password that we have used in previous applications. If you
have any problems opening the attached file, please let me know. Please review the
application and drawings carefully for accuracy and completeness, making any changes,
additions, or corrections, if any, directly on the application (or electronically with
changes tracked).

Please recall that the application must clearly explain the best mode of practicing the
invention for which protection is desired. Also, the application must explain to an
individual of ordinary skill in the art how to make and use the invention. After reviewing
the application, please forward any comments to Ben Withrow and me. We will then send you
a revised draft of the application, along with formal paperwork prepared for your
signature. After receipt of the signed paperwork and approval from Nortel's legal
department, we will file the application.

Please do not hesitate to contact Ben Withrow or me should you have any questions
regarding the application. Thank you for allowing us to be of service to you and for your
prompt attention to this matter.

Best regards,

Jennifer Rush Alkove

Withrow & Terranova, PLLC

201 Shannon Oaks Circle, Suite 200

Cary, NC 27511

Ph: 919-654-4570 Fax: 919-654-4521

WARNING! This message may contain information that is confidential and/or protected under
the attorney-client or other lawfully recognized privilege. If you received this message
in error or through inappropriate means, please REPLY to this message to notify the Sender
that the message erroneously was received by you, and then permanently delete this message
from all storage media, without forwarding or retaining a copy.

Checked by AVG Free Edition.
Version: 7.5.503 / Virus Database: 269.15.12/1097 - Release Date: 10/28/2007 1:58 PM

Appendix C

	Nortel Case Status					
Updated						
Matter ID	First draft sent	First draft received back	Final draft sent (IP Law)	Final draft comments received back (IP Law)	Formal paperwork sent	Formal paperwork received back	Actual filing date (Prov.)
7000-341	2/26/2004	3/12/2004	3/15/2004	4/13/2004	3/15/2004	3/19/2004	4/14/2004